

ESTTA Tracking number: **ESTTA102009**Filing date: **10/02/2006**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91170560
Party	Defendant Knud Nielsen Company, Inc. Knud Nielsen Company, Inc. 217 Park Street Evergreen, AL 36401
Correspondence Address	NATHAN W. JOHNSON BRADLEY ARANT ROSE & WHITE LLP 1819 FIFTH AVENUE NORTH BIRMINGHAM, AL 35203-2104
Submission	Answer and Counterclaim
Filer's Name	Nathan W. Johnson, Applicant's Attorney
Filer's e-mail	njohnson@bradleyarant.com, IPDocketing@bradleyarant.com
Signature	/Nathan W Johnson/
Date	10/02/2006
Attachments	2006-10-02Answer&CounterclaimsX2-FilingPack.pdf ( 22 pages )(884895 bytes )

## Registrations Subject to Cancellation

Registration No	2371399	Registration date	07/25/2000
Registrant	POULSEN ROSER A/S KRATBJERG 332 FREDENSBORG, DK3480 DENMARK		
Goods/Services Subject to Cancellation	Class 031. First Use: 1996/12/01 , First Use In Commerce: 1996/12/01 Goods/Services: Live rose plants		
Grounds for Cancellation	The registered mark has become the generic name for the goods.		
	The registered mark has been abandoned.		
Registration No	2634152	Registration date	10/15/2002
International Registration No.	NONE	International Registration Date	NONE
Registrant	Poulsen Roser ApS Hillerodvejen 49 Fredensborg, 3480 DENMARK		
Goods/Services Subject to Cancellation	Class 031 Goods/Services: natural plants and flowers		

Nathan W. Johnson

Direct Dial: 205-521-8369  
Direct Fax: 205-488-6369  
njohnson@bradleyarant.com

October 2, 2006

**Filed Via ESTTA**  
UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**RE: Opposition Number: 91170560**  
**Mark: PARTY PALETTE (Serial No. 78/547,410)**  
**Applicant: Knud Nielsen Company, Inc.**  
**Opposer: Poulsen Roser A/S**  
**Answer and TWO Counterclaims**

Dear Sirs:

With this letter I have enclosed the Applicant's Answer and Counterclaims in connection with Opposition Number 91170560. This filing is being made by the electronic filing system. A payment of \$600 (\$300 x 2 counterclaims) will be submitted via ESTTA with this filing, but an authorization to charge deposit account is attached in the event the ESTTA system fails to process or request such payment.

Yours very truly,

  
Nathan W. Johnson

NWJ  
Enclosures

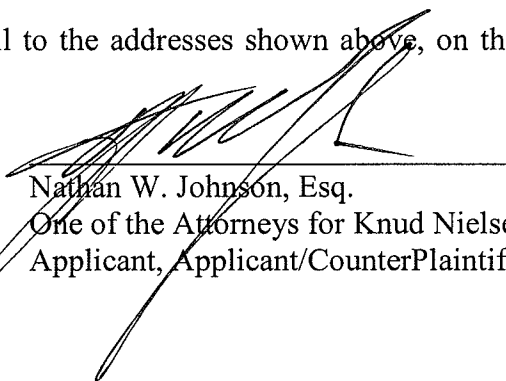
**CERTIFICATE OF SERVICE**

I hereby certify that I have this date served the attached Answer regarding Opposition No. 91170560 and Counterclaims against Reg. Nos. 2,634,152 and 2,371,399, on the following:

Mr. Louis K. Ebling  
Greenebaum Doll and McDonald PLLC  
2800 Chemed Center  
255 East Fifth Street  
Cincinnati, Ohio 45202-4728

by deposit in First Class U.S. Mail to the addresses shown above, on the date set forth by my signature, below.

October 2, 2006  
Date

  
Nathan W. Johnson, Esq.  
One of the Attorneys for Knud Nielsen Company, Inc.  
Applicant, Applicant/CounterPlaintiff

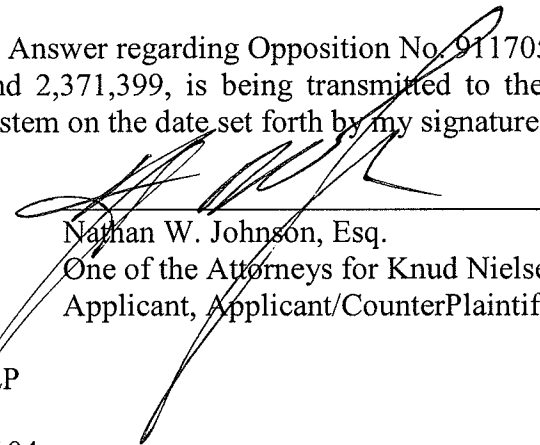
**OF COUNSEL**

Bradley Arant Rose & White LLP  
1819 Fifth Avenue North  
Birmingham, Alabama 35203-2104  
Telephone: 205-521-8369  
Facsimile: 205-488-6369

**CERTIFICATE OF SUBMISSION VIA ESTTA**

I hereby certify that the attached Answer regarding Opposition No. 91170560 and Counterclaims against Reg. Nos. 2,634,152 and 2,371,399, is being transmitted to the Trademark Trial and Appeal Board via the ESTTA system on the date set forth by my signature, below.

October 2, 2006  
Date

  
Nathan W. Johnson, Esq.  
One of the Attorneys for Knud Nielsen Company, Inc.  
Applicant, Applicant/CounterPlaintiff

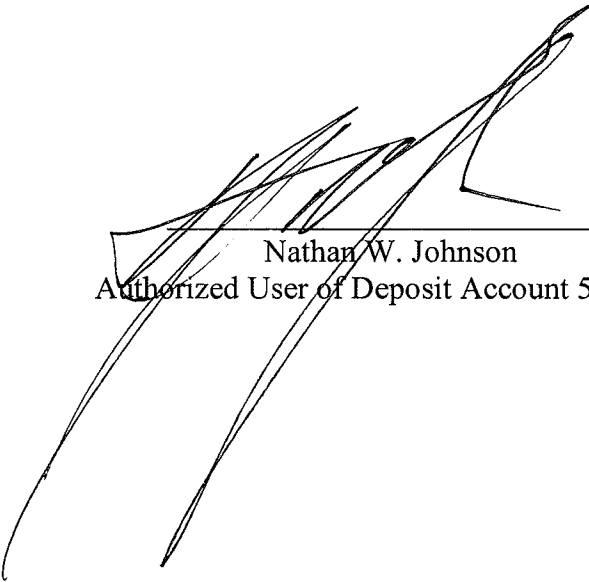
**OF COUNSEL**

Bradley Arant Rose & White LLP  
1819 Fifth Avenue North  
Birmingham, Alabama 35203-2104  
Telephone: 205-521-8369  
Facsimile: 205-488-6369

**AUTHORIZATION TO CHARGE**  
**DEPOSIT ACCOUNT**

The Commissioner is authorized to pay any charges, fees, or sums due in connection with this correspondence, I hereby authorize the Commissioner of Patents and Trademarks to charge all such remaining fees, charges, and other sums due to Deposit Account Number 50-0954.

Date: October 2, 2006



Nathan W. Johnson  
Authorized User of Deposit Account 50-0954

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<b>POULSEN ROSER A/S,</b>	)	
	)	
<b>Opposer,</b>	)	<b>Opposition No. 91170560</b>
	)	
<b>v.</b>	)	<b>Serial No. 78/547,410</b>
	)	
<b>KNUD NIELSEN COMPANY, INC.</b>	)	<b>Mark: PARTY PALETTE</b>
	)	
<b>Applicant.</b>	)	

**ANSWER AND COUNTERCLAIMS**

**ANSWER OF APPLICANT**  
**AND**  
**COUNTERCLAIMS FOR CANCELLATION**  
**OF REGISTRATION NUMBERS 2,634,152 AND 2,371,399**

Applicant, Knud Nielsen Company, Inc. ("Applicant"), for its answer to the Notice of Opposition, the time for response thereto having been extended to October 2, 2006, by virtue of stipulation of the parties entered by the Board, states as follows in response to the numbered paragraphs (and preamble) of the Notice of Opposition filed by Poulsen Roser A/S ("Opposer"):

Preamble: The preamble, preceding the numbered paragraphs, is a rhetorical statement regarding the nature of the case and contains no allegations against Applicant that require response. To the extent any allegation is contained within this paragraph, it is denied.

1. Admitted.
2. Applicant admits that the United States Patent and Trademark Office Trademark Trial and Appeal Board ("TTAB") granted extensions of the deadline for

Opposer to file an opposition, which extended the deadline to file an opposition until April 23, 2006, per the TTAB's order mailed February 23, 2006. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining averments in Paragraph 2, if any, and so states, which has the effect of denial.

3. Applicant admits that the records of the United States Patent and Trademark Office report: (i) registration on July 25, 2000 on the Principal Register of Registration No. 2,371,399 under Section 1(a) of the Lanham Act for the mark PARTY for goods described as "live rose plants" in International Class 31; (ii) Opposer is the assignee of Registration No. 2,371,399 pursuant to the assignment recorded at Reel/Frame 3281/0899; (iii) a claimed date of first use of the mark that is the subject of Registration No. 2,371,399 on December 1, 1996; and (iv) a claimed date of first use in commerce of the mark that is the subject of Registration No. 2,371,399 on December 1, 1996. Applicant further admits that the records of the United States Patent and Trademark Office report registration on October 15, 2002 on the Principal Register of Registration No. 2,634,152 under Section 44(e) of the Lanham Act for the mark PAILLETTE for goods described as "natural plants and flowers" in International Class 31. Applicant DENIES, based on the United States Patent and Trademark Office TESS and assignment records, that Opposer Poulsen Roser A/S is the owner of Registration No. 2,634,152. Applicant DENIES that Registration Nos. 2,371,399 and 2,634,152 are valid. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining averments in Paragraph 3, and so states, which has the effect of denial.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in Paragraph 4, and so states, which has the effect of denial.

5. Denied.

6. Applicant denies that priority is not an issue. Applicant admits that the records of the United States Patent and Trademark Office report that the filing date of Application Serial No. 78/547,410 is subsequent to the date of registration of Registration Nos. 2,371,329 and 2,634,152. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining averments in Paragraph 6, if any, and so states, which has the effect of denial.

7. Denied.

8. Applicant admits that the records of the United States Patent and Trademark Office report Registration No. 2,371,399 is registered for the mark PARTY for goods described as “live rose plants” in International Class 31. Applicant admits that the records of the United States Patent and Trademark Office report Registration No. 2,634,152 is registered for the mark PAILLETTE for goods described as “natural plants and flowers” in International Class 31. Applicant admits that the description of goods for Application Serial No. 78/547,410 is “dried and natural flowers; arrangements of dried and natural flowers” in International Class 31. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining averments in Paragraph 8, if any, and so states, which has the effect of denial.

9. Denied.

10. Denied.

11. Applicant admits that Opposer has no control over the nature and quality of Applicant's goods under the mark that is the subject of Application Serial No. 78/547,410. The remaining averments in Paragraph 11 are denied.

12. Denied.

13. Applicant admits that registration of the mark that is the subject of Application Serial No. 78/547,410 would create statutory rights under the Trademark Act of 1946 in favor of Applicant. The remaining allegations in Paragraph 13 are denied.

### **Defenses and Reservations**

1. Applicant denies the material allegations of the Notice of Opposition.
2. Opposer is not the owner of trademark rights in, or a registration for, one or more of the marks asserted.
3. Opposer' claims are barred by the doctrine of laches.
4. Opposer' claims are barred by the doctrine of estoppel.
5. Opposer' claims are barred by the doctrine of acquiescence.
6. The Opposer's use of the marks alleged by it, if any, is use merely as a generic name for a plant variety and not as a trademark.
7. The Opposer's use of one or more of the marks alleged by it, if any, is use merely to reserve a right in a mark.
8. The Opposer's use of one or more of the marks alleged by it, if any, is not in the ordinary course of trade and is not "use in commerce" sufficient to be cognizable use supporting rights under the Lanham Act or otherwise.



9. One or more of Opposer's claims are barred because Opposer is not the owner of record of the registration relied upon, or otherwise does not have standing or capacity to raise such claims alleged in the Notice of Opposition.

10. Opposer's claims are barred by the doctrine of waiver.

11. Opposer's claims are barred by the doctrine of release.

12. Opposer's claims are barred by the doctrine of unclean hands.

13. Opposer's trademark applications are invalid, and/or void ab initio

14. Applicant pleads all applicable defenses available to Applicant under 15 U.S.C. §1115(b).

15. Opposer's claims are barred because Opposer has abandoned the marks.

16. Applicant reserves the right to amend its Answer to assert additional affirmative or supplemental defenses after completion of further investigation and discovery.

WHEREFORE, Applicant requests that this Opposition Number 91170560 be dismissed.

FIRST COUNTERCLAIM FOR CANCELLATION,  
AGAINST REGISTRATION NUMBER 2,634,152

Applicant Knud Nielsen company, Inc. ("Applicant/CounterPlaintiff") asserts the following First Counterclaim for Cancellation, of Registration Number 2,634,152, for the mark PAILLETTE in further response to the Notice of Opposition.

Opposer/Counterclaim Defendant Poulsen Roser A/S ("Opposer/CounterDefendant") asserts Registration Number 2,634,152 for PAILLETTE for "natural

plants and flowers” as a basis for opposition. Applicant believes that it is or will be damaged by the continued existence on the Register of said registration, at least in part due to Opposer/Counterclaim Defendant’s assertion of the registration against Applicant, and hereby petitions to cancel said registration. The grounds for cancellation are as follows:

1. Applicant/CounterPlaintiff is a corporation organized and existing under the laws of the State of Alabama, having a business address located at 217 Park Street, Evergreen, Alabama 36401.

2. Upon information and belief, based upon the records of the Trademark Office TESS and assignment systems, the name and address of the current owner of the registration sought to be cancelled by this Counterclaim is Poulsen Roser ApS; Hillerodvejen 49; Fredensborg 3480; Denmark. By virtue of the allegations set forth in the Notice of Opposition 91170560, it appears that Poulsen Roser A/S may also claim an interest, having an address (upon information and belief) at Kratbjerg 332, Fredensborg, 3480, Denmark.

3. Opposer, Poulsen Roser A/S, has filed the opposition No. 91170560 to which this counterclaim relates, asserting ownership of Registration Number 2,634,152 for PAILLETTE registered on October 15, 2002 under Section 44(e) of the Lanham Act for “natural plants and flowers.” Neither of Opposer/CounterDefendant or Poulsen Roser ApS (being the last owner reported) have, as of the date of filing hereof, filed a statement of use or allegation of use or amendment to allege use of the mark that is the subject of Registration Number 2,634,152.

4. Registration Number 2,634,152 is the basis of a challenge under Opposition 91170560 to application number 78/547,410 by Applicant/CounterPlaintiff, and Applicant/CounterPlaintiff therefore will be damaged by its continued existence on the register, as well as by the fact that the continued existence will hamper the scope of rights available to Applicant/CounterPlaintiff in light of the rights that would be presumed from the continued existence of such registration.

#### ABANDONMENT

5. A trademark registered under the section of the Lanham Act which provides for United States registration of a foreign trademark based on ownership of a registration in the registrant's home country, without any use in the United States, may be cancelled on the ground of abandonment of the mark at any time. Lanham Trade-Mark Act, §§ 14(c), 44(e), 15 U.S.C.A. §§ 1064(c), 1126(e)

6. Under the Lanham Act, non-use for three consecutive years establishes a prima facie case of abandonment. 15 U.S.C. § 1127.

7. Upon information and belief, neither Opposer/CounterDefendant or the last listed registrant Poulsen Roser ApS has, as of the date of filing hereof, made bona fide use in commerce within the United States of America of the mark that is the subject of Registration Number 2,634,152.

8. Upon information and belief, Registration Number 2,634,152 has not been in use in the United States for three consecutive years.

9. Upon information and belief, Registration Number 2,634,152 is due to be cancelled on the ground of abandonment. 15 U.S.C. § 1127.

### WRONGFUL DECLARATION

10. Upon information and belief, the applicant of Registration Number 2,634,152 made a false, material misrepresentation of fact in connection with the filing or prosecution of the application that resulted in Registration Number 2,634,152 when such applicant executed the declaration or oath, sworn to under penalty of perjury, to the effect that such applicant had a bona fide intention to use the mark applied for in commerce on or in connection with the following goods: “agricultural, horticultural and forestry products and grains not included in other classes; living animals; fresh fruits and vegetables; seeds, live plants and flowers; foodstuffs for animals, malt,” in that at the least such statement was not correct as to “living animals” and possibly other goods alleged.

11. Upon information and belief, at the time of execution of the declaration or oath referenced in paragraph 10 immediately above, the relevant applicant did not have a bona fide intention to use the mark applied for in commerce on or in connection with all of the goods described in the application.

12. Registration Number 2,634,152 and the mark shown therein are void or otherwise invalid for fraud on the United States Patent and Trademark Office in the filing or prosecution of the application that resulted in Registration Number 2,634,152.

13. This Counterclaim for Cancellation is timely filed pursuant to 15 U.S.C. 1064(1) & (3), 37 C.F.R. § 2.106(b)(2)(i), and TBMP 313.04. Applicant/CounterPlaintiff reserves the right to add additional grounds following or during discovery.

WHEREFORE, Applicant/CounterPlaintiff requests that Registration Number 2,634,152 be cancelled in its entirety.

SECOND COUNTERCLAIM FOR CANCELLATION,  
AGAINST REGISTRATION NUMBER 2,371,399

Applicant Knud Nielsen company, Inc. (“Applicant/CounterPlaintiff”) asserts the following Second Counterclaim for Cancellation, of Registration Number 2,371,399, for the mark PARTY in further response to the Notice of Opposition.

Opposer/Counterclaim Defendant Poulsen Roser A/S (“Opposer/CounterDefendant”) asserts Registration Number 2,371,399 for PARTY for “live rose plants” as a basis for opposition. Applicant believes that it is or will be damaged by the continued existence on the Register of said registration, at least in part due to Opposer/Counterclaim Defendant’s assertion of the registration against Applicant, and hereby petitions to cancel said registration. The grounds for cancellation are as follows:

1. Applicant/CounterPlaintiff is a corporation organized and existing under the laws of the State of Alabama, having a business address located at 217 Park Street, Evergreen, Alabama 36401.

2. Upon information and belief, to the best of the knowledge of Applicant/CounterPlaintiff, the name and address of the current owner of the registration sought to be cancelled by this Counterclaim is Poulsen Roser A/S, Kratbjerg 332 Fredensborg Denmark 3480.

3. Registration Number 2,371,399 is the basis of a challenge under Opposition 91170560 to application number 78/547,410 by Applicant/CounterPlaintiff, and Applicant/CounterPlaintiff therefore will be damaged by its continued existence on the register, as well as by the fact that the continued existence will hamper the scope of

rights available to Applicant/CounterPlaintiff in light of the rights that would be presumed from the continued existence of such registration.

#### GENERIC – PROMINENT PORTION OF CULTIVAR NAME

4. Upon information and belief, the term “Party” is a prominent portion of one or more varietal or cultivar names for a variety or varieties of live roses, or is the varietal or cultivar name itself, and therefore is generic. See TMEP § 1202.12. See, e.g., Exhibit A.

#### GENERIC – NAME OF TYPE OF PLANT

5. Upon information and belief, the term “Party” amounts to a generic name of a plant, variety, or type of plant that is known to the public and does not function as a trademark. See TMEP § 1202.12; 15 U.S.C. §§1051, 1052 and 1127. See, e.g., Exhibit B.

#### ABANDONMENT

6. Upon information and belief, the term “Party” is used by multiple third parties not under the control of Opposer/CounterDefendant, including in the names of varieties of live roses, and is not capable of functioning as a designator of a single source. To the extent, if any, that the term once if ever functioned as a trademark, by virtue of allowing such third party uses, Opposer/CounterDefendant has abandoned the mark. See, e.g., Exhibits A and B.

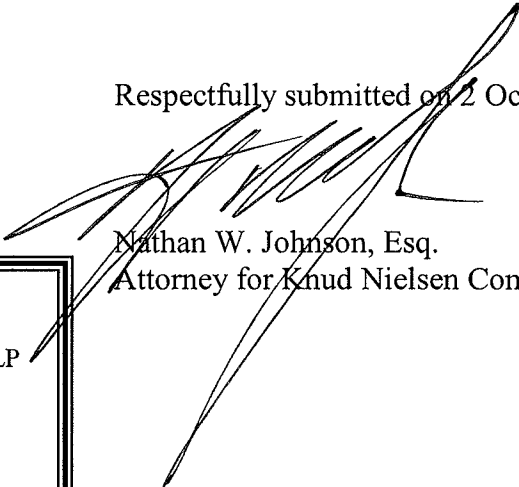
7. Upon information and belief, Registration Number 2,371,399 for PARTY for “live rose plants” is generic, is used by multiple third parties in the name of varieties of live roses, and does not function as a trademark, and thus, is not entitled to continued registration and is due to be cancelled.

8. This Counterclaim for Cancellation is timely filed pursuant to 15 U.S.C. 1064(1) & (3), 37 C.F.R. § 2.106(b)(2)(i), and TBMP 313.04. Applicant/CounterPlaintiff reserves the right to add additional grounds following or during discovery.

WHEREFORE, Applicant/CounterPlaintiff requests that Registration Number 2,371,399 be cancelled.

Applicant submits the above counterclaims with appropriate payment in the amount of \$600, for the filing by a single petitioner against the single International Class 31 in each of the subject registrations, Registration Number 2,634,152 and Registration Number 2,371,399. Applicant/CounterPlaintiff further authorizes the drawing of any underpayment from deposit account 50-0954, for which the undersigned is an authorized user.

Respectfully submitted on 2 October 2006,

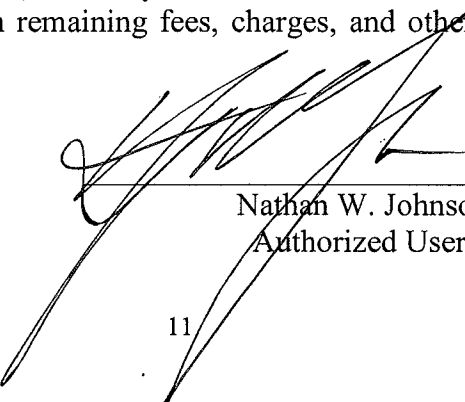
  
Nathan W. Johnson, Esq.  
Attorney for Knud Nielsen Company, Inc.

<p><b>OF COUNSEL</b> Nathan W. Johnson, Esq. BRADLEY ARANT ROSE &amp; WHITE LLP 1819 Fifth Avenue North Birmingham, Alabama 35203-2104 Telephone: 205-521-8369 Facsimile: 205-488-6369</p>
--

**AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

If, after processing the above and enclosed papers, any charges, fees, or sums due remain unpaid in connection therewith, I hereby authorize the Commissioner of Patents and Trademarks to charge all such remaining fees, charges, and other sums due to Deposit Account Number 50-0954.

Date: October 2, 2006

  
\_\_\_\_\_  
Nathan W. Johnson  
Authorized User

**Exhibit A**



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Search results for: party

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[Previous Page](#) | **Page: 1 2**

Key:    **Botanical Name**                      **Common Name(s)**    What do these terms mean?

Cultivar:	<b>Rosa 'Party Popcorn'</b>	<b>Rose 'Party Popcorn'</b>	
	<a href="#">[List All Plants in this Genus]</a>	<a href="#">[More Info]</a>	<a href="#">[Add Your Comments and/or Image]</a>
Cultivar:	<b>Rosa 'Party Time'</b>	<b>Rose 'Party Time'</b>	
	<a href="#">[List All Plants in this Genus]</a>	<a href="#">[More Info]</a>	<a href="#">[Add Your Comments and/or Image]</a>
Cultivar:	<b>Rosa 'Partyglo'</b>	<b>Rose 'Partyglo'</b>	
	<a href="#">[List All Plants in this Genus]</a>	<a href="#">[More Info]</a>	<a href="#">[Add Your Comments and/or Image]</a>
Cultivar:	<b>Rosa 'Tea Party'</b>	<b>Rose 'Tea Party'</b>	
	<a href="#">[List All Plants in this Genus]</a>	<a href="#">[More Info]</a>	<a href="#">[Add Your Comments and/or Image]</a>
Cultivar:	<b>Tulipa 'Garden Party'</b>	<b>tulip 'Garden Party'</b>	
	<a href="#">[List All Plants in this Genus]</a>	<a href="#">[More Info]</a>	<a href="#">[Add Your Comments and/or Image]</a>

Key (more info):

**Families    Genera    Species    Groups/Grexes    Cultivars**



= images



= opinions



= info links  
vendor links



= image links



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*List of Link Sources*

Search the HortiPlex Database:

Please enter a common name or a botanical name:

 party

- ☒ Include all records    ☐ Only records with images  
☐ Only records with vendor links    ☐ Only records of botanical taxa

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- Searches may be limited to: just those records with images or links to images; records with vendor links; or, records of botanical taxa.
- Multiple words are searched so that each word must appear in each hit (boolean "and") and they must appear in the same order, though there may be intervening characters.
- If you are unsure of the ending of a word, use only the first part of the word that you know to be correct.
- If you are unsure if a name should be written as one word or two words, enter it as two words and it will match either case.
- **Additional Passes:** If there are no hits in the first search, common word endings (-ing, -es, -ed, -ly) are stripped from the keywords and a second pass is made. If there is still no match, all non-word characters are stripped.
- See the help page for an explanation of terms used.
- If you feel there are plants missing from the database that should be included, please [submit them](#) and we will try to add them.
- Links are provided to a variety of [sources](#) and new [link submissions](#) meeting our criteria are accepted.
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- You can see the entire list [page by page](#), or a single page listing of [all families \(large file\)](#) or [all genera \(VERY large file\)](#).



Will  
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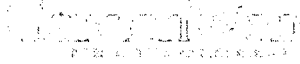
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Click on a Name or Thumbnail for further information.

Name and Description

**Charisma** rb Red blend, Floribunda 1977



**Garden Party** w White & White blend, Hybrid Tea 1959



**Garden Party** mr Medium Red, Floribunda 1999

**Party Girl** yb Yellow Blend, Miniature 1979

**Party Popcorn** w White & White blend, Miniature 1993

**Party Time** yb Yellow Blend, Hybrid Tea 1986

**Partyglo** yb Yellow Blend, Miniature

**Tea Party** ab Apricot & Apricot blend, Miniature 1972

1 - 8 of 8.

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party

## P

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L,N,P	Party Lights
L	Party Pink
	Party Popcorn
C,F,G,L,N,P	Party Time
G,L	Party Trick™
F,L	Partyglo™

A: AWARDS	L: LINEAGE
C: COMMENTS/QUESTIONS	N: NURSERIES
F: REFERENCES	P: PHOTOS
G: GARDENS	R: RATINGS/VOTES

**Exhibit B**

# Roses

and everything rose & gardening related.

HelpMeFind

Glossary

## Party Roses

Party Roses grow to a maximum height of 8 cm.